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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Graham Russell

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10/06/2006

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EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3691

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/665,846	Applicant(s) RUSSELL ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 7, 13, 14, 19 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 13, 14, 19 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 18 July 2006.

Status of Claims

2. Claims 1, 2, 7, 13, 14, 19 and 25-28 are currently pending.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 7, 13, 14, 19 and 25-28 have been considered but are moot in view of the new ground(s) of rejection as discussed below. Therefore claims 1, 2, 7, 13, 14, 19 and 25-28 stand rejected and Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1, 2, 7, 13, 14, 19 and 25-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1 and 13, the Examiner finds these claims to lack a tangible result because they do not produce a real-world result. The final step of claim 1 states “associating a unique group of logical tracer document items with the entry when the determination in (a) is negative.” The step does not actually output or process the associated steps.

With respect to claims 2, 7, 14, 19 and 25-28, the Examiner finds the claims to lack a tangible result because they do not produce a real-world result. The final step of claim 25 states “associating the group of logical tracer document items with all batches of document items received from the branch during the predetermined period of time so as to allow further downstream processing of the batches of documents items at a later time. However, the claims do not actually include later processing of the batches of documents.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 7, 13, 14, 19 and 25-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner notes that the claims are unclear because the body of the claim does not produce a result commiserate with the stated purpose of the preamble. Claims 1 and 13 recites

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“A method of operating in image-based item processing system to process an entry which is a unit of work comprising a plurality of batches of physical document items” yet the claims fail to include a single step which processes an entry and does not mention batches of physical documents. Claims 7 and 19 contain similar limitations with respect to “batches” as discussed for claim 1.

Claim 25 recites the limitation "assigning a unique entry number to all batches of documents" in section (d). This renders the claim indefinite because it is unclear whether batches of documents are ever received. Claim 25 merely recited “capturing at a branch images of physical document items without use of a group of physical tracer document items.” There is no suggestion that the documents are in batches. Claims 26-28 are rejected for similar reasons to that of claim 25.

With respect to claims 1, 13, 27 and 28, the phrase “when the determination in (a) is negative” renders the claim indefinite because it is unclear what “negative” means with respect to the determination.

With respect to claims 2, 7, 14 and 19 the phrase “as if the plurality of batches of physical document items associated with the entry had been processed with a unique group of physical tracer document items” renders the claim indefinite because it is unclear whether this step is actually being performed and instead appears to be non-functional descriptive material.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 7, 13, 14, 19, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Garner IV et al. (hereinafter Garner) U.S. Patent 6,863,214.

Regarding claims 1 and 13, Garner discloses a method of operating an image-based item processing system to process an entry which is a unit of work comprising a plurality of batches of physical document items, the method comprising:

determining whether a group of physical tracer document items is associated with an entry (column 2, line 33 thru column 3, line 47); and

associating a unique group of logical tracer document items with the entry when the determination is negative (column 2, lines 33-60 and column 4, lines 38-65).

Regarding claims 2, 7, 14 and 19, Garner discloses a method of operating a distributed image capture proof-of-deposit system having a central processing site and a number of branches connected via a network with the central processing site, the method comprising the steps of:

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capturing at a branch images of a plurality of batches of physical document items associated with an entry without using a group of physical tracer document items (column 3, lines 8-27);

transferring the captured images from the branch via the network to the central processing site (column 3, line 60 thru column 4, line 14);

receiving at the central processing site the images transferred from the branch (column 3, line 60 thru column 4, line 14); and

associating a unique logical group of tracer document items with the images received at the central processing site so as to allow the received images of physical document items to be later processed as if the plurality of batches of physical document items associated with the entry had been processed with a unique group of physical tracer document items (column 4, lines 15 thru column 5, line 13).

Claims 27 and 28, Garner teaches a method of operating an encoding workstation of an image-based item processing system to process physical document items which are contained in a number of document trays without using a group of physical tracer document items in the document trays, the method comprising the steps of:

determining whether a group of physical tracer document items is included in a tray of physical document items (column 2, line 33 thru column 3, line 47);

associating a unique group of logical tracer document items with the tray of physical document items when the determination is negative (column 4, lines 15 thru column 5, line 13).

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assigning a logical pocket number to each logical tracer document item in the unique group of logical tracer document items (column 4, lines 15 thru column 5, line 13);

for each logical tracer document item, encoding a physical blank document item with information associated with the particular logical tracer document item (column 4, lines 15 thru column 5, line 13); and

for each encoded item, routing the encoded physical document item to a physical pocket which has been assigned the logical pocket number (column 4, lines 15 thru column 5, line 13).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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13. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garner IV et al. (hereinafter Garner) U.S. Patent 6,863,214 in view of Foley U.S. Patent 6,381,342.

Regarding claims 25 and 26, Garner teaches a method of operating a distributed image capture proof-of-deposit system having a central processing site and a number of branches connected via a network with central processing site, the method comprising:

Capturing at a branch images of physical document times without use of a group of physical tracer document items (column 3, lines 8-27);

transferring the captured images of physical document items without use of a group of physical tracer document items (column 3, line 60 thru column 4, line 14);

receiving at the central processing site the images transferred from the branch(column 3, line 60 thru column 4, line 14);

assigning a batch slip to all batches of documents (column 2, lines 39-47);

creating a group of logical tracer document items based upon encoded data (column 4, lines 15-65); and

associating the group of logical tracer document items with all batches of document items received from the branch during so as to allow further downstream processing of the batches of documents at a later time (column 3, line 60 thru column 4, line 15).

Garner fails to teach that the assigned batch slip is a unique entry number. Foley teaches a method for reading and sorting documents in which batch headers contain unique numbers and they are logically sorted in part based on the batch headers (column 4, lines 45-65). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's

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invention to modify the teachings of Garner and include the teachings of Foley because it provides for greater association between the batches of documents when processing checks.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
Stefano Karmis
22 September 2006



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